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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,923	12/21/2001	William R. Matz	36968/267874 (BS01424)	5050

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EXAMINER

LE, UYEN T

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,923

Applicant(s)

MATZ ET AL.

Examiner

Uyen T. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 22 is/are allowed.
- 6) ☒ Claim(s) 1,3-14,16-21,23-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant has not provided the status of related applications cited at page 1 of the specification. Appropriate correction is required.
2. The information disclosure statement filed 4 February 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.
3. Applicant's arguments have been fully considered but they are not persuasive. Applicant merely argues that Hendricks does not teach or suggest all the features of independent claims 1, 17 and 24 without pointing out where the examiner errs in interpreting Hendricks.

Applicant seems to argue the claims as amended. Applicant argues that because Hendricks is silent to the preference rating, Hendricks in no way teaches or suggests the features of claim 1, 17 and 24. In response, Applicant seems to ignore the level of ordinary skill in the pertinent art. Although Hendricks does not specifically show a "preference rating attribute", Hendricks clearly teaches the concept of monitoring viewer's preferences (see Figure 24, viewer profile database 314, Figure 26, update access history files). Hendricks further teaches advertising targeting (see Figure 25),

advertisement targeting (see Figure 28). Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed preference rating attribute in order to select advertisement to targeted viewers depending on their interests.

Applicant further argues that "claims 1, 17 and 24 are not obvious of Cook". The examiner had not cited any "Cook" reference. It is not clear what applicant's argument meant.

For all the reasons discussed above, rejection to claims 1-14, 16-21, 23-36 is maintained using the reference of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14, 16-21, 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because claim 1, lines 7-8, claim 17, lines 10-11 "the preference ranking attribute" lacks antecedent basis.

Art rejection is applied to claims 1-14, 16-21, 23 as best understood in light of the rejection under 35 U.S.C. 112, second paragraph discussed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14, 16-21, 23-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (US 6,463,585) of record, provided by the applicant.

Regarding claim 1, Hendricks discloses all the claimed subject matter (see the abstract, column 3, lined 30- column 4, line 17, column 59, line 52- column 60, line 13, column 63, line 59- column 64, line 21, column 66, line 58- column 67, line 44). The claimed "receiving a preference...database" is met by the fact that the access history file is received by the network controller. The claimed "searching a content...said preference", "receiving a first option list...an option" and "delivering...subscriber" are met by the fact that the subscriber is presented a menu of options (see column 58, lines 16-23). Although Hendricks does not specifically show a preference rating attribute, Hendricks clearly teaches the concept of monitoring viewer's preferences (see Figure 24, viewer profile database 314, Figure 26, update access history files). Hendricks further teaches advertising targeting (see Figure 25), advertisement targeting (see Figure 28). Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed preference rating attribute in order to select advertisement to targeted viewers depending on their interests.

Regarding claims 3, 5, 16, 18, 23, although Hendricks does not specifically show sorting as claimed, it would have been obvious to one of ordinary skill in the art to do so in order to rank advertisements according to viewers preferences.

Regarding claim 4, the content-access-history database in the method of Hendricks has to comprise a category attribute as claimed in order to match advertisements to subscribers preferences.

Regarding claims 6, 7 Hendricks discloses a television viewing history database (see the abstract).

Regarding claim 8, Hendricks discloses multi-level menu of options (see column 16, line 55- column 17, line20).

Regarding claim 9, Hendricks discloses an electronic program guide (see Figure 2).

Regarding claim 10, the claimed image displayed on a television screen merely reads on the advertisement delivered to a viewer (see the abstract).

Regarding claim 11, the option menu of Hendricks clearly provides access to a second option list since Hendricks teaches multi-level menus (se column 17, lines 9-11).

Claim 12 merely reads on the fact that the option in Hendricks allows viewers to access targeted advertisements (see column 58, lines 16-23).

Regarding claim 13, Hendricks discloses sending the option list to a television set-top box (see the abstract, Figure 1).

Regarding claim 14, the option list is clearly displayed for viewer selection (see column 58, lines 16-23).

Claims 17, 19, 20, 21 correspond to a computer program product to perform the method of claims 1, 4, 13, 14, thus are rejected for the same reasons stated in claims 1, 4, 13, 14 above.

Claims 24, 25, 26, 27, 32, 33 correspond to a system for claims 1, 4, 6, 7, 9, 12, thus are rejected for the same reasons stated in claims 1, 4, 6, 7, 9, 12 above.

Regarding claims 28, the option list creator application has to comprise and application executing on a set-top box in the method of Hendricks since the user of the set-top box can select from the menu of options (see column 58, lines 16-23).

Regarding claim 29, Hendricks discloses said option list creator application comprises an application executing on a processor in a content provider facility when Hendricks shows that targeted advertisements are generated by the network controller and signal processor (see column 57, lines 6-15).

Regarding claim 30, Hendricks discloses a cable television provider head-end facility (see column 57, lines 16-21).

Regarding claim 31, Hendricks discloses said option list creator application comprises a menu creator application (see column 58, lines 16-23).

Regarding claim 34, Hendricks discloses said content source comprises a cable television station (see column 57, lines 16-21).

Regarding claim 35, Hendricks discloses said content source comprises a video-on-demand server (see Figure 12, item 306).

Regarding claim 36, although Hendricks does not specifically show a content source of personal video recorder, it would have been obvious to one of ordinary skill in the art to include any source in order to obtain available content of interest to a subscriber.

Conclusion

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16 May 2005



UYEN LE
PRIMARY EXAMINER